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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,088	11/25/2000	Paul Lapstun	NPS028US	4151
24011	7590	06/18/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			JORGENSEN, LELAND R	
			ART UNIT	PAPER NUMBER
			2675	12

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,088

Applicant(s)

LAPSTUN ET AL.

Examiner

Leland R. Jorgensen

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 11, 14 - 29, and 31 - 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 11, 14 - 29, and 31 - 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application is a continuation in part of parent application number 09/575,168, now issued as USPN 6,737,591 B1. Claims 1, 3 – 11, 14 – 29, and 31 – 33 essentially mirror the claims in the parent application and would be allowed over the prior art cited for the reasons stated when the parent application was allowed.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2675

3. Claims 1, 3 – 11, 14 – 29, and 31 – 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 31 of U.S. Patent No. 6,737,591 B1 in view of Bennett et al., USPN 5,051,736.

Claim 1 of 6,737,591 read as follows

1. A sensing device for generating orientation data when positioned or moved relative to a surface, the surface having coded data disposed upon it, the coded data being indicative, when sensed by the sensing device, of the orientation, the sensing device including:

- a housing containing an orientation sensor and a transmitter;
- the orientation sensor configured to generate the orientation data using at least some of the coded data, the orientation data being indicative of three dimensions of a rotational orientation of the sensing device relative to the surface;
- and the transmitter configured to communicate the orientation data to a computer system.

Claim 1 of the present application is nearly identical but adds that the sensing device generates position data. The position data is indicative of at least two dimensions of the sensing device relative to the surface.

Although several claims of the parent application hint at such position data, see e.g. claims 8, 9, 16, and 19, the parent claims do not specifically state that the sensing device generates position data as opposed to orientation data.

Bennett teaches a sensing device for generating position data. The orientation data is indicative of an position of the sensing device [positional input device or stylus 10] relative to the surface [passive tablet 1]. The sensing device generates position data. Bennett, col. 5, lines 5 – 10, 22 – 23, figure 1. Bennett also teaches that sensor may generate tilt angle. Bennett, col. 11, lines 59 – 62. The surface has coded data disposed upon the surface. The coded data has a plurality of substantially undifferentiated marks [small dots] positioned relative to a set of

Art Unit: 2675

predetermined nominal marking positions [larger dots] and is indicative, when sensed by the sensing device, of the position. Bennett, col. 9, lines 57 – 62; and figure 6. Bennett shows the stylus having a housing. Bennett, figure 2. A orientation sensor is configured to generate the position data using the coded data. Bennett, col. 5, lines 22 – 33; and figures 1 and 2. A communicator [communications link 11 or cable 7] is configured to communicate the orientation data to a computer system. Bennett, col. 5, lines 22 – 33; and figure 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the sensing device for generating position data as taught by Bennett with the sensing device for generating orientation data as taught by the parent application to produce a sensing device that corrects parallax as the sensing device determine its nib position relative to the surface. Bennett invites such combination by teaching,

It is also possible to determine the tilt angle of the stylus (a potentially useful piece of information in some applications) by analyzing the perspective distortion of the TAC shape. More important, using this angle and knowledge of the indices of refraction of the tablet materials, the offset from parallax can be corrected.

Bennett, col. 11, lines 59 – 64.

The remaining claims in this application are dependant on claim 1 and essentially mirror the dependant claims in the parent application.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leland Jorgensen whose telephone number is 703-305-2650. The examiner can normally be reached on Monday through Friday, 7:00 a.m. through 3:30 p.m..

Art Unit: 2675

Any response to this action should be mailed to:

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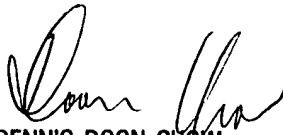
or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Technology Center 2600 Customer Service Office, telephone number
(703) 306-0377.

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DENNIS-DOON CHOW
PRIMARY EXAMINER